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Dated: July 24, 2006

Signature: 
(Christine Grace)

Docket No.: ALEX-P02-077
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Toshiaki et al.

Application No.: 10/737,252

Confirmation No.: 6679

Filed: December 15, 2003

Art Unit: 1637

For: ENGINEERED TEMPLATES AND THEIR
USE IN SINGLE PRIMER AMPLIFICATION

Examiner: Suchira Pande

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY TO RESTRICTION REQUIREMENT

Sir:

In response to the outstanding Restriction Requirement mailed June 23, 2006, Applicants hereby elect, with traverse, Group II (claims 9 and 11), drawn to IgA antibodies. Applicants traverse the restriction requirement for the reasons which follow.

Applicants note that according to MPEP §803, two criteria must be met for a proper restriction requirement:

- a. The inventions must be independent or distinct as claimed; and
- b. There must be a serious burden on the Examiner if restriction is required.

Applicants respectfully submit that in this case, the Examiner has not shown that there would be a serious burden in examining the Groups set forth in the restriction requirement. In particular, Applicants note that it appears that the search for Groups II and III would be co-extensive. Indeed, claim 11 relates to a product produced by the process of Group III (claim 10). It appears that a search covering the subject matter of Group II would cover the subject matter of Group III also. Thus, Applicants respectfully submit that the inventions of Groups II and III can be efficiently searched and examined together without placing a significant additional burden on

the Examiner. Based on these reasons, Applicants respectfully request that the restriction requirement, at least with respect to Groups II and III, be withdrawn.

To the extent that the Examiner requires Applicants to elect a single subgroup consisting of a single primer from SEQ ID NOs: 296-309, Applicants elect with traverse SEQ ID NO: 296, for search purposes only. Applicants respectfully traverse the sequence election requirement for the following reasons.

First of all, Applicants submit that the various sequences subject to election requirement are encompassed by a Markush group. Pursuant to MPEP 803.02, “[i]f the members of the Markush group are sufficiently few in number or so closely related that a search and examination of the entire claim can be made without serious burden, the examiner must examine all claims on the merits, even though they are directed to independent and distinct inventions.” In addition, Applicants respectfully point out that the search of the Markush-type claim will be extended to non-elected species should no prior art be found that anticipates or renders obvious the elected species (MPEP 803.02). In this case, it is Applicants’ position that the members of the Markush group are “sufficiently few in number” and may be searched and examined without a serious burden on the Office.

Second, Applicants note that MPEP § 803.04 states that “to further aid the biotechnology industry in protecting its intellectual property without creating an undue burden on the Office, the Commissioner has decided *sua sponte* to partially waive the requirements of 37 C.F.R. 1.141 *et seq.* and permit a reasonable number of such nucleotide sequences to be claimed in a single application.” The MPEP goes on to state that “it has been determined that normally **ten** sequences constitute a reasonable number for examination purposes” (emphasis added). Applicants respectfully request the Examiner to allow at least ten primer sequences for search and examination.

Finally, Applicants submit that non-elected primer sequences SEQ ID NOs: 297-309 share a high degree of sequence similarity to the elected primer SEQ ID NO: 296. For example, SEQ ID NOs: 297-299 and 302-309 each differ from SEQ ID NO: 296 in only 1-3 nucleotides (see a sequence alignment of SEQ ID NOs: 296-309, enclosed herewith as **Exhibit A**). One of skill in the art would understand that all primers function equally well.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the sequence election requirement and request a search and examination of at least ten sequences as claimed herein.

CONCLUSION

The Examiner may address any questions raised by this submission to the undersigned at 617-951-7000. Should an extension of time be required, Applicants hereby petition for same and request that the extension fee and any other fee required for timely consideration of this submission be charged to **Deposit Account No. 18-1945**.

Dated: July 24, 2006

Respectfully submitted,

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